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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,668	09/07/2000	Jiangchun Xu	210121.484C3	2196

7590 09/03/2002  
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EXAMINER

SHEINBERG, MONIKA B

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 09/03/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/656,668

Applicant(s)

XU ET AL.

Examiner

Monika B Sheinberg

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 3,4,6-8,13,22 and 65.

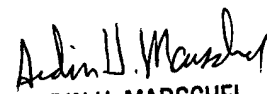
Claim(s) withdrawn from consideration: 1,2,9-12,17-21,23-25 and 27-64.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 16.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: The proposed amendments would require further consideration and/or search with respect to enablement of limitations such as recited in claim 3, line 4, "identity to the entirety of SEQ ID NO: 198" that introduce a substantial change in the instant invention. The same limitation would require further consideration or search with respect to the entirety of the elected sequence in the prior art.

Continuation of 10. Other: Declaration of Steven P. Fling Ph.D., Under 37 CFR 1.132

The Declaration still lacks sufficient evidence to detect ovarian cancer. There is no indication about whether or not expression levels are significant in such that the levels must reach a critical level in order for detection. As stated in the final action mailed 17 June 2002, with a sequence of 50 contiguous nucleotides of SEQ ID NO: 198, no utility would predictably result from detection unless the functional or active residues responsible for the ovary tumor-specificity are in the set of 50; the same is true for the 90% homologous sequence that would require the functional or active regions be not disrupted by a mismatch of the 10% non-homologous. Further, the mere presence of a particular transcript does not speak to whether any encoded cancerous or pre-cancerous protein is produced. Lacking any data values for the control samples, applicant is making allegations without factual evidence. Lacking evidence supporting specificity of the sequence for a particular cell type, one of skill in the art would have reasonable doubt that this particular sequence would be useful as a cancer marker sequence.

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER